REMARKS

Claim 1 has been amended. Claims 1-3 are now pending in this application. Support for the amendments is found in the existing claims and the specification as discussed below. Accordingly, the amendments do not constitute the addition of new matter. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Rejection under 35 U.S.C. § 101

Claims 1-3 are rejected under 35 U.S.C. § 101 as lacking patentable utility due to being unsupported by either specific and/or substantial utility or a well established utility.

The specification states that the object of the invention is to produce DNA having an arbitrary sequence. The Examiner argues that producing an arbitrary sequence is not immediately useful.

While it is true that the term "arbitrary" implies without design, the term here was meant to convey that the target sequence was arbitrarily selected. The user can choose any sequence to reproduce without the restrictions of the prior art methods. The confusion most likely arises from the translation of the application into English. However, it is clear from a review of the method steps that there is an intended target sequence and that oligomers are designed with a specific target sequence in mind.

Furthermore, a review of the specification indicates that the term "arbitrary" only occurs on pages 1 and 2 of the specification. Clearly, the method encompasses design of specific sequences. However, if necessary to overcome the rejection, Applicants are willing to cancel the term from the present specification.

In view of Applicants' arguments, reconsideration and withdrawal of this ground of rejection is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph because the specification, while being enabling for a method for producing DNA when N>1, does not reasonably provide enablement for producing a DNA when N=1.

There is an obvious error in the definition of N. As seen from the description of the present specification, the main feature of the present invention is the stepwise production of DNA (see page 6, lines 7-24, for example). In view of the description, it is apparent that at least

four fragments are necessary for the stepwise production of DNA. For the same reasons, n is larger than 1 in claim 2.

In view of Applicant's amendment and the discussion above, withdrawal of the rejection is requested.

Claims 1 is rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for a method for producing the target DNA does not reasonably provide enablement for producing a partial sequence of the target DNA , as recited in step 6b.

The Examiner states that step 6b states that sequencing of synthesized DNA is performed and DNA is selected that has a nucleotide sequence containing the (N-J)th to (N+1+J)th partial sequences thereby producing the target sequence. However, (N-J) and (N+1+J) sequences may or may not represent the first sequence and therefore, a complete target DNA could not be formed.

This rejection is believed to be overcome by the amendment to claim 1 discussed above.

CONCLUSION

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Nov. 7, 2003

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